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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/531,821	04/18/2005	Vineet Sharma	09669/064001	3942

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EXAMINER
PHUONG, DAI

ART UNIT	PAPER NUMBER
2617	

DATE MAILED: 10/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
	10/531,821	SHARMA, VINEET
Office Action Summary	Examiner	Art Unit	
	Dai A. Phuong	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *18 April 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some *   c)☐ None of:

        1.☒ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1.   The references listed in the Information Disclosure Statement filed on 06/01/2006 has

been considered by the examiner (see attached PTO-1449 form or PTO/SB/08A and 08B).

Claim Rejections - 35 USC § 102

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed
> in the United States before the invention by the applicant for patent or (2) a patent granted on an application for
> patent by another filed in the United States before the invention by the applicant for patent, except that an
> international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this
> subsection of an application filed in the United States only if the international application designated the United
> States and was published under Article 21(2) of such treaty in the English language.

3.   Claims 1-2, 5 and 7-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Tuiler

(Pub. No: 20040235467).

        Regarding claim 1, Tuiler discloses a method for managing phone numbers attribution

after replacement of a first portable object (SCA) 16 by a second portable object (SCB) 14, the

first portable object (SCA) 16 being coupled to a communication device (CD) 60 arranged to

communicate with a network, the first portable object (SCA) comprising a first identification

data (IMSI.sub.A, ADM.sub.A, Ki.sub.A) identifying a first phone number (MSISDNA) (fig. 1,

[0029] to [0066]), wherein the method comprises the following steps:

        a first sending step, in which the communication device (CD) sends to an application

server (AS) a message including a second identification data identifying a second phone number

(MSISDNB) assigned to the second portable object (SCB) (fig. 1, [0029] to [0066]. It is inherent

that the apparatus and/or system include software and hardware to perform these tasks); an inserting step, in which the second portable object (SCB) is inserted in the communication device (CD), the second portable object (SCB) comprising a second identification data (IMSI.sub.B, ADM.sub.B, Ki.sub.B) identifying the second phone number (MSISDN.sub.B) (fig. 1, [0029] to [0066]. It is inherent that the apparatus and/or system include software and hardware to perform these tasks); and a second sending step, in which an application server (AS) sends a message (M2) for replacing, in the second portable object (SCB), the second identification data (IMSI.sub.B, ADM.sub.B, Ki.sub.B) by the first identification data (IMSI.sub.A, ADM.sub.A, Ki.sub.A) attached to the first phone number (MSISDN.sub.A) (fig. 1, [0029] to [0066]. It is inherent that the apparatus and/or system include software and hardware to perform these tasks).

Regarding claim 2, Tuiler discloses all the limitations in claim 1. Further, Tuiler discloses the method wherein the method further comprises a using step, in which a user uses the second portable object (SCB) with the first phone number (MSISDN.sub.A) (fig. 1, [0029] to [0066]).

Regarding claim 5, Tuiler discloses all the limitations in claim 1. Further, Tuiler discloses the method wherein in the second sending step, the application server (AS) sends a secure message (fig. 1, [0029] to [0066]).

Regarding claim 7, Tuiler discloses all the limitations in claim 2. Further, Tuiler discloses the method herein in the using step, the communication device (CD) communicates with the network using the second portable object (SCB), the first phone number

(MSISDN.sub.A,) and the first identification data (IMSI.sub.A, ADM.sub.A, Ki.sub.A) (fig. 1,

[0029] to [0066]).

Regarding claim 8, this claim is rejected for the same reason as set forth in claim 1.

Regarding claim 9, Tuiler discloses a portable object (SCB) 16 comprising first

identification data (IMSI.sub.B, ADM.sub.B, Ki.sub.B) identifying a first a phone number

(MSISDN.sub.B), the portable object 16 being arranged to be coupled to a communication

device (CD) 60, the communication device (CD) 60 being arranged to communicate with an

application server via a communication network, the application server storing second

identification data (IMSI.sub.A, ADM.sub.A, Ki.sub.B) identifying a second phone number

(MSISDN.sub.A), wherein the portable object comprises a microcontroller including a program

arranged to perform a receiving step in which the microcontroller is arranged to receive a request

from the application server for replacing the first identification data (IMSI.sub.B, ADM.sub.B,

Ki.sub.B) by the second identification data (IMSI.sub.A, ADM.sub.A, Ki.sub.A) (fig. 1, [0029]

to [0066]. It is inherent that the apparatus and/or system include software and hardware to

perform these tasks).

Regarding claim 10, Tuiler discloses a communication device 60 (CD) being arranged to

be coupled to a first portable object (SCA) 16, the communication device (CD) 60 being

arranged to communicate with an application server via a communication network, the portable

object (SCA) comprising first identification data (IMSI.sub.A, ADM.sub.A, Ki.sub.A)

identifying a first phone number (MSISDN.sub.A), wherein the communication device (CD) 60

is arranged to send to the application server a message comprising a second identifying data

identifying a second phone number (MSISDNB) assigned to a second portable object (SCB) 14

(fig. 1, [0029] to [0066]. It is inherent that the apparatus and/or system include software and

hardware to perform these tasks).

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

5.   Claim 3 rejected under 35 U.S.C. 103(a) as being unpatentable over Tuiler (Pub. No:

20040235467) in view of Reemtsma (Pub. No: 20050075137).

Regarding claim 3, Tuiler discloses all the limitations in claim 1. However, Tuiler does

not disclose the method wherein before the first sending step, the application server (AS) sends a

secure message (step 3) for deleting, in the first portable object (SCA), the first identification

data (IMSI.sub.A, ADM.sub.A, Ki.sub.A).

In the same field of endeavor, Reemtsma discloses the method wherein before the first

sending step, the application server (AS) sends a secure message (step 3) for deleting, in the first

portable object (SCA), the first identification data (IMSI.sub.A, ADM.sub.A, Ki.sub.A) ([0030]

to [0031]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the

invention was made to modify the mobile apparatus of Tuiler by specifically including disclose

the method wherein before the first sending step, the application server (AS) sends a secure

message (step 3) for deleting, in the first portable object (SCA), the first identification data

(IMSI.sub.A, ADM.sub.A, Ki.sub.A), as taught by Reemtsma, the motivation being in order to

provide that the proper activation of the new SIM card and deactivation of the old SIM card are

carried out while in dialog with the subscriber via a migration server connected to the mobile

communications network.

6.   Claims 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuiler

(Pub. No: 20040235467) in view of Reemtsma (Pub. No: 20050075137) and further in view of

Sonera Oy (International Publication Number: WO 98/56201).

Regarding claim 4, the combination of Tuiler and Reemtsma disclose all the limitations

in claim 1. However, the combination of Tuiler and Reemtsma do not disclose the method

wherein the secure message (M3) is encrypted, the encryption being performed by using an

encryption key attached to the portable object (SCA), and by using an algorithm that resides both

on the Application Server (AS), and on the portable object (SCA).

In the same field of endeavor, Sonera Oy discloses the secure message (M3) is encrypted,

the encryption being performed by using an encryption key attached to the portable object

(SCA), and by using an algorithm that resides both on the Application Server (AS), and on the

portable object (SCA) (page 1, lines 25-35 and page 2, line 31 to page 3, line 30).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the

invention was made to modify the mobile apparatus of Tuiler by specifically including the secure

message (M3) is encrypted, the encryption being performed by using an encryption key attached

to the portable object (SCA), and by using an algorithm that resides both on the Application

Server (AS), and on the portable object (SCA), as taught by Sonera Oy, the motivation being in

order to allow better and faster customer service in respect of subscriber identity modules.

Regarding claim 6, this claim is rejected for the same reason as set forth in claim 4.

Conclusion

7.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

Ala-Luukko (Pub. No: 20030050047) change a subscriber identifier

8.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dai A Phuong whose telephone number is 571-272-7896. The examiner can normally be reached on Monday to Friday, 9:00 A.M. to 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nguyen M Duc can be reached on 571-272-7503. The fax phone number for the organization where this application or proceeding is assigned is 571-273-7503.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dai Phuong
AU: 2617
Date: 08-11-2006

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PRIMARY EXAMINER